REMARKS/ARGUMENTS

This Amendment and the following remarks are intended to fully respond to the Office Action mailed March 6, 2006. In that Office Action, claims 1-3, 12-15, 17-19, and 21-24 were examined, and all claims were rejected. More specifically, claims 1-3, 12-15, 17-19, and 21-24 have been rejected under obviousness-type double patenting; and claims 1-3, 12-15, 17-19, and 21-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Beyda (U.S. Patent No. 6,275,850). Reconsideration of these rejections, as they might apply to the original and amended claims in view of these remarks, is respectfully requested.

The amendments submitted above to certain paragraphs in the specification have been done so to correct informalities, such as switched, omitted, or incorrect figure reference characters or numbers, or inconsistent reference names, and to correct grammatical or spelling errors.

The Examiner requested that the status of the parent application be updated. In response, a paragraph has been added to the specification to cross reference the present application to its parent.

The amendment made to the paragraph bridging pages 10 and 11 was done to correct a reference number (Arithmetic Logic Unit (ALU) "50" should be Arithmetic Logic Unit (ALU) "48"), and to add an inadvertently omitted reference number ("registers" should be "registers 50") in order to conform the written specification to the figures (see FIG. 2).

The amendments submitted above to certain claims have been done so either in response to the Examiner's rejections or objections or to correct claim dependency, to correct antecedent basis, to put the claim in conventional form, to correct punctuation, improper word usage, and the like.

Claims 14 and 19 were amended to correct claim form as the word "and" was inadvertently omitted after the penultimate claim elements in each of the claims.

Claim 2 was amended to keep it consistent with the amendment made to claim 1 from which it depends.

Claims 1-3, 12-15, 17-19, and 21-24 remain present for examination.

A. Rejection of Claims
Double Patenting

The Examiner has rejected claims 1-3, 12-15, 17-19, and 21-24 under obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,647,409. In response to the rejection, Applicant is submitting herewith a terminal disclaimer under 37 CFR 1.321(c) disclaiming the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,647,409. Withdrawal of the rejection under obviousness-type double patenting in respect to these claims is respectfully requested.

B. Rejection of Claims
Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3, 12-15, 17-19, and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Beyda et al., U.S. Patent No. 6,275,850.

In response, Applicant has amended independent claim 1 to more distinctly distinguish Applicant's invention, and traverses the rejection with respect to claims 2-3, 12-15, 17-19, and 21-24.

Claim 1 has been amended through the further limitation of:

> "comparing the information for items on the server to information for items on the client computer system"

Support for this amendment may be found in the specification on page 21, line 21 through page 22, line 5 in reference to FIGS. 5 and 6, and page 27, line 25 through page 28, line 8 in reference to FIGS. 7a, 7b, and7c. Independent claims 13, 18, and 21 contain a similarly worded limitation.

In general, the present invention relates to handheld computers and more specifically to messaging software running on the handheld computer controlling the interaction between a

handheld computer and a server computer. The amount of memory available for use by the handheld computer is typically considerably less than relatively large desktop PCs that typically hold substantially more memory, both operational memory and long-term storage memory. The memory constraint significantly impacts the amount of data that can be downloaded to and stored on the handheld computer during a communications session. As a result, it may be possible to download too much data at one time, which could potentially consume all the available memory and cause significant problems related to functionality and performance. Email provides unique risks with respect to potentially downloading too much information during a particular session because the sizes of email message are unpredictable and may be quite large. Emails may also have very large attachments. A particular user may receive an excessive number of email messages between sessions that could potentially consume significant amounts of storage memory.

The present invention solves the above and other problems by selective retrieval by a handheld computer of items, such as email messages, from a server and the selective maintenance of the email messages on the client in order to minimize the impact on the handheld computer's memory. The retrieval is based on predetermined criteria, such as predetermined date, size, or keyword information. The predetermined criteria is also used to delete local copies of the email messages from memory in the handheld computer.

The present invention thus provides a sliding view of server-based data on the handheld computer. That is, the items present on the handheld computer reflect only those items that satisfy a predetermined criteria. These criteria may change or "slide" to effectively provide a sliding view of the server-based data items to the user of the client handheld computer. The sliding view provides for significant memory conservation. Items that do not satisfy the criteria are not downloaded if they are on the server, and are deleted if they are in memory on the handheld computer. Thus, memory in the handheld computer is released for use by other resources or items.

Turning now to the cited art, Beyda et al. is directed to an entirely different problem and solution. Beyda et al. is concerned with increased user management of electronic message transmissions between servers and client devices, particularly transmissions of files attached to

electronic messages, and the amount of time it takes to transmit electronic messages between servers and client devices, especially electronic messages having large attachments (col. 1, lines 39-44). When accessing electronic messages with attached files stored at a server by a user, attached files that satisfy a prescribed requirement are automatically downloaded form the server to the client device utilized by the user (col. 2, lines 28-37). Beyda et al. is concerned about attachment size, the estimated download time from the server to the client, and the connection speed between the server and the client (col. 2, lines 51-63), and certain file formats of the attachments (col. 3, lines 4-21). By setting up criteria to filter out large file attachments, or estimated time to download based upon attachment size and/or connection speed between the server and the client, or file format, the user can minimize the time it takes for automatic downloads from the server to the client. Optionally, once an email message and its file attachment have failed the criteria for automatic downloading, the email may be downloaded without the attachment (col. 4, lines 57-61).

Beyda et al. does not teach the comparison of items on the server with items on the client device. Indeed, there is no reason for Beyda et al. to do so. Beyda et al. is only concerned with downloading large attachments to emails to client devices, with no regard to what information may already resides on the client device.

Beyda et al. does not teach analyzing items on the server that are not on the client device against predetermined criteria. Again, Beyda et al. has no reason to do so because what information may already reside on the client device is of no concern for the problem to be solved.

Beyda et al. does not teach the deletion of any data from the client device for any reason whatsoever, let alone as a result of analyzing items on the server that are not on the client device against predetermined criteria. In Beyda et al., all data is preserved both on the client device and on the server. At most, a file attachment may not be sent to the client device because of the time it would take to download, but the attachment is preserved on the server. The problem Beyda et al. is trying to solve is one of minimizing the time it takes to perform automatic downloads from the server to the client, and memory concerns are not even mentioned. Applicant's invention, on the other hand, is trying to solve a memory problem. The deletion of data has a direct impact

upon memory usage whereas time to download data per se does not. The deletion of data only becomes obvious when the problem to be solved is one of memory usage. Beyda et al. does not teach or suggest deleting data because deleting data is not a part of the solution to the problem Beyda et al. is trying to solve.

Since Beyda et al. does not teach or suggest all of the elements of amended claim 1 and original claims 13, 18, and 21, and since it would not be obvious to one skilled in the art to incorporate the missing elements found in Applicant's invention based upon the teaching of Beyda et al., Applicant believes that independent claims 1, 13, 18, and 21 are patentable over Beyda et al. and in view of one skilled in the art. Accordingly, Applicant requests retraction of the Examiner's rejection of these claims under 35 U.S.C. §103(a).

Claims 2-3, 12, 14-15, 17, 19, and 22-24, through dependency, embody all the elements and limitations of independent claims 1, 13, 18, and 21. As argued above, Applicant believes that Beyda et al. does not teach or suggest all the elements and limitations of Applicant's independent claims 1, 13, 18, and 21, and that it would not be obvious to one skilled in the art to supply the missing elements in light of the teaching of Beyda et al. Thus, Applicant believes that dependent claims 2-3, 12, 14-15, 17, 19, and 22-24, through dependency, are patentable as well. Accordingly, Applicant requests retraction of the Examiner's rejection of these claims under 35 U.S.C. §103(a).

Conclusion

Please charge the fee for the terminal disclaimer to deposit account number 13-2725. It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this Response to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Dated: June 5, 2006

Stanley J. Gradisar, #42,598
Attorney/Agent for Microsoft Corporation
MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903
303.357.1632